

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Johannes Hakansson

Confirmation No.: 1566

Serial No.: 10/538,293

Group Art Unit: 2622

Filed: June 10, 2005

Examiner: Henn, Timothy J.

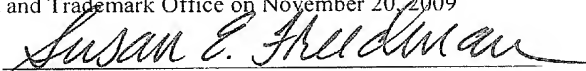
For: **CREATING EFFECTS FOR IMAGES**

Date: November 20, 2009

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CERTIFICATION OF TRANSMISSION

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APPELLANT'S BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Sir:

This Appeal Brief is filed pursuant to the "Notice of Appeal to the Board of Patent Appeals and Interferences" filed September 9, 2009 and the "Notice of Panel Decision from Pre-Appeal Brief Review" mailed October 20, 2009.

Real Party In Interest

The real party in interest is assignee Sony Ericsson Mobile Communications AB, Lund, Sweden.

Related Appeals and Interferences

Appellant is aware of no appeals or interferences that would be affected by the present appeal.

Status of Claims

Appellant appeals the final rejection of Claims 1 - 16 as set forth in the Final Office Action of June 9, 2009 (hereinafter "Final Action"). Claims 1 - 16 stand rejected. Claims 17 and 18 have been canceled without prejudice or disclaimer. The claims involved in the appeal as included in Appellant's response to the Office Action mailed December 23, 2008 are attached hereto as Appendix A.

Status of Amendments

No amendment has been filed in the present case in response to the Final Action.

Summary of Claimed Subject Matter

Independent Claim 1 is directed to a method of providing storable image effects in a cellular phone comprising: generating an effect for application on digital images based on entries of a user (Specification, page 8, lines 2 – 14; FIG. 4, block 30), storing the effect as an effects file in a defined standardised image editor independent effects format (Specification, page 8, lines 16 – 18; FIG. 4, block 38), and transferring the effects file to another device, such that it is used for later application on more than one image, the multiple images not being associated with one another (Specification, page 8, lines 18 – 30; FIG. 4, block 42).

Independent Claim 8 is directed to a cellular phone for providing storable image effects comprising: an image effects store (Specification, page 7, lines 10 – 14; FIG. 3, block 24), an image editor (Specification, page 7, lines 10 – 14; FIG. 3, block 20) arranged to generate a new effect for application on digital images based on entries of a user (Specification, page 8, lines 2 – 14; FIG. 4, block 30) and allowing storing of said effect as an effects file in the image effects store in a defined standardised image editor independent effects format (Specification, page 8, lines 16 – 18; FIG. 4, block 38), and at least one transmitting unit (Specification, page 7, lines 15 – 24; FIG. 3, blocks 26, 19, and 21) configured to transmit effect files to at least one other device, such that the files are used for later application on more than one image, the multiple images not being associated with one another (Specification, page 8, lines 18 – 30; FIG. 4, block 42).

Independent Claim 15 is directed to an image editor for providing storable image effects in a cellular phone comprising: a processor (Specification, page 7, lines 10 – 12; FIG. 3, block 20) configured to generate a new effect for application on digital images based on entries of a user (Specification, page 8, lines 2 – 14; FIG. 4, block 30), to allow storing of said effect as an effects files in an image effect store in a defined standardised image editor independent effects format (Specification, page 8, lines 16 – 18; FIG. 4, block 38), and to order a transmitting unit to transmit effect files to at least one other device, such that the files are used for later application on more than one image, the multiple images not being associated with one another (Specification, page 8, lines 18 – 30; FIG. 4, block 42).

Independent Claim 16 is directed to a computer program product for enabling provision of storable image effects in a cellular phone comprising a computer readable medium having computer program code thereon (Specification, page 9, lines 24 – 35; FIG. 7, block 58). The computer program code comprises computer program code configured to generate a new effect for application on digital images based on entries of a user (Specification, page 8, lines 2 – 14; FIG. 4, block 30), computer program code configured to allow storing of said effect as an effects file in an image effect store in a defined standardisation image editor independent effects format (Specification, page 8, lines 16 – 18; FIG. 4, block 38), and computer program code configured to order a transmitting unit to transmit effect files to at least one other device, such that the files are used for later application on more than one image, the multiple images not being associated with one another (Specification, page 8, lines 18 – 30; FIG. 4, block 42).

Grounds of Rejection to be Reviewed on Appeal

Claims 1 – 5, 7 – 12, and 14 – 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 7,038,716 to Klein et al. ("Klein") in view of U. S. Patent Publication No. 2003/0071903 to Nakami ("Nakami") and further in view of U. S. Patent Publication No. 2003/0063198 to Yokokawa ("Yokokawa"). (Final Action, page 2).

Claims 6 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Klein in view of Nakami, Yokokawa, and further in view of U. S. Patent No. 5,913,088 to Moghadam et al. ("Moghadam"). (Final Action, page 5).

Argument

I. Introduction to 35 U.S.C. §103 Analysis

A determination under §103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office (USPTO) has the initial burden under §103 to

establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest all the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. §2143. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U. S. 1, 15 (2007). A corollary principle is that, when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be unobvious. *Id.* at 12. If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Id.* at 13. A Court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 13. When it is necessary for a Court to look at interrelated teachings of multiple patents, the Court must determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *Id.* at 14.

Appellant respectfully submits that the pending claims are patentable for at least the reason that the cited references do not disclose or suggest each of the recitations of the independent claims. The patentability of the pending claims is discussed in detail hereinafter.

A. Claims 1 - 16 are Patentable

Independent Claims 1, 8, 15, and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Klein in view of Nakami and further in view of Yokokawa. (Final Action, page 2). Independent Claim 1 recites:

generating an effect for application on digital images based on entries of a user;

storing the effect as an effects file in a defined standardised image editor independent effects format; and

transferring the effects file to another device, such that it is used for later application on more than one image, the multiple images not being associated with one another. (Emphasis added).

According to independent Claim 1 the effects file is transferred to another device where it is subsequently used on more than one image, which are not associated with one another. Independent Claims 8, 15, and 16 include similar recitations.

The Final Action acknowledges that Klein fails to disclose an image effects store, but alleges that Nakami provides the missing teachings. (Final Action, page 2). Nakami is directed to an image output system where a digital camera generates an image file that includes both image data and output control data (PIM), which are used in the printing process. (Nakami, paragraph 54; FIG. 1). The Final Action alleges that the output control data PIM corresponds to the effects file recited in the independent claim. (Final Action, pages 2 and 3). As explained in paragraph 79 of Nakami, however, the output control data used for processing/printing an image taken by a digital camera includes standard settings along with additional custom settings that can be set/modified by the photographer so that a specific image prints according to the photographer's particular taste. Nakami, therefore, teaches against using the output control data on a printer for more than one image as the other images may be associated with other photographers and/or the same photographer may wish to process/print images differently based on the particular subject matter featured in the image.

The Final Action acknowledges that Nakami fails to disclose or suggest using the same effect for multiple images, but alleges that Yokokawa provides the missing teachings. (Final Action, page 3). The Final Action cites Yokokawa as disclosing the ability to use a camera to capture images on different days (Yokokawa, FIGS. 3A and 3B) and under different shooting conditions (Yokokawa, FIGS. 7A and 7B). The Final Action alleges that "it would be obvious to select a common effect to be applied to these images (Nakami, Figure 5)." (Final Action, page 3). As discussed above, however, Nakami does not suggest applying a common effect to multiple images that are not associated with one another. Nakami teaches against applying a common effect to multiple images when printing the images because the images may be associated with different photographers and/or the same photographer may wish to process/print images differently based on the particular subject matter featured in the image. Thus, Yokokawa fails to remedy the deficiencies in Klein's and Nakami's teachings as Yokokawa merely discloses the ability to acquire images that are not associated with one another. Appellant submits that the combination of Klein, Nakami, and Yokokawa fails to disclose or suggest, at least, transferring an effects file to another

device, such that it is used for later application on more than one image, which are not associated with one another.

For at least the foregoing reasons, Appellant respectfully submits that independent Claims 1, 8, 15, and 16 are patentable over Klein, Nakami, and Yokokawa and that the pending dependent claims are patentable, at least, by virtue of their depending from an allowable claim. Accordingly, Appellant respectfully requests that the rejection of Claims 1 - 16 be reversed based on the failure of the Examiner to establish a prima facie case of obviousness under 35 U.S.C. §103 for at least these reasons.

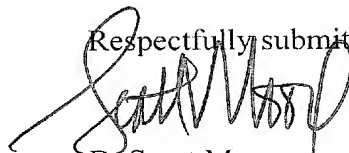
B. Claims 6 and 13 are Patentable

Dependent Claims 6 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Klein in view of Nakami, Yokokawa, and further in view of Moghadam. (Final Action, page 5). Dependent Claims 6 and 13 depend from independent Claims 1 and 8, respectively, which Appellant submits are patentable for at least the reasons discussed above in Section IA. Appellant submits that dependent Claims 6 and 13 are patentable over the cited references at least by virtue of their depending an allowable claim. *Ex parte Ligh*, 159 U.S.P.Q. (BNA) 61, 62 (Bd. App. 1967). Accordingly, Appellant respectfully requests that the rejection of Claims 6 and 13 be reversed based on the failure of the Examiner to establish a prima facie case of obviousness under 35 U.S.C. §103 for at least these reasons.

II. Conclusion

In summary, Appellant respectfully submits that, with respect to Claims 1 - 16 the cited references do not teach all of the recitations of the claims. Accordingly, Appellant respectfully requests reversal of the rejection of Claims 1 - 16 based on the cited references.

Respectfully submitted,


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APPENDIX A – CLAIMS APPENDIX

1. (Previously presented) A method of providing storable image effects in a cellular phone comprising:

generating an effect for application on digital images based on entries of a user;

storing the effect as an effects file in a defined standardised image editor independent effects format; and

transferring the effects file to another device, such that it is used for later application on more than one image, the multiple images not being associated with one another.

2. (Previously Presented) A method according to claim 1, wherein the format is provided through an XML (Extensible Markup Language) file.

3. (Previously Presented) A method according to claim 1, wherein the step of storing the effect comprises storing the file with parameter settings made by a user.

4. (Previously Presented) A method according to claim 1, wherein transferring the effects is performed over a wireless medium.

5. (Previously Presented) A method according to claim 1, wherein the effect comprises a matrix of calculations to be performed on pixels of an image.

6. (Previously Presented) A method according to claim 1, further comprising applying the effect on an image before storing and storing the effect as the effects file after detecting acceptance from a user of the cellular phone.

7. (Previously Presented) A method according to any previous claim 1, wherein generating an effect comprises retrieving a stored effects file and modifying the stored effects file with a new effect.

8. (Previously presented) A cellular phone for providing storable image effects comprising:

an image effects store;

an image editor arranged to generate a new effect for application on digital images based on entries of a user and allowing storing of said effect as an effects file in the image effects store in a defined standardised image editor independent effects format; and

at least one transmitting unit configured to transmit effect files to at least one other device, such that the files are used for later application on more than one image, the multiple images not being associated with one another.

9. (Previously Presented) A cellular phone according to claim 8, wherein the format is provided through an XML (Extensible Markup Language) file.

10. (Previously Presented) A cellular phone according to claim 8, wherein the image editor is arranged to store the file with parameter settings made by a user.

11. (Previously Presented) A cellular phone according to claim 8, wherein the at least one transmitting unit is configured to transmit effect files over a wireless interface.

12. (Previously Presented) A cellular phone according to claim 8, wherein the effect comprises a matrix of calculations to be performed on an image.

13. (Previously Presented) A cellular phone according to claim 8, wherein the image editor is further configured to apply the effect on an image before storing and storing the effect as an effects file after detecting acceptance from a user.

14. (Previously Presented) A cellular phone according to claim 8, wherein the image editor when generating the effect is arranged to retrieve a stored effects file from the image effect store and apply a new effect to said file.

15. (Previously presented) An image editor for providing storable image effects in a cellular phone comprising:

a processor configured to generate a new effect for application on digital images based on entries of a user, to allow storing of said effect as an effects files in an image effect store in a defined standardised image editor independent effects format, and to order a transmitting unit to transmit effect files to at least one other device, such that the files are used for later application on more than one image, the multiple images not being associated with one another.

16. (Previously presented) A computer program product for enabling provision of storable image effects in a cellular phone comprising:

a computer readable medium having computer program code thereon, the computer program code comprising:

computer program code configured to generate a new effect for application on digital images based on entries of a user;

computer program code configured to allow storing of said effect as an effects file in an image effect store in a defined standardisation image editor independent effects format; and

computer program code configured to order a transmitting unit to transmit effect files to at least one other device, such that the files are used for later application on more than one image, the multiple images not being associated with one another.

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APPENDIX B – EVIDENCE APPENDIX

None

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APPENDIX C – RELATED PROCEEDINGS APPENDIX

None.